

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOOKAN KIM

Appeal No. 98-1042
Application 08/449,069¹

ON BRIEF

Before COHEN, MEISTER, and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Kookan Kim originally took this appeal from the final rejection of claims 5 and 21 through 23, all of the claims pending in the application.² The examiner has since allowed

¹ Application for patent filed May 24, 1995.

² Claims 5 and 22 have been amended subsequent to final rejection.

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claim 22. Thus, the appeal as to claim 22 is hereby dismissed, leaving for review the standing rejection of claims 5, 21 and 23. We reverse.

The invention relates to "a writing instrument which has a sanitary moistener to facilitate turning sheets of paper, such as pages of a book" (specification, page 1). A copy of appealed claims 5, 21 and 23 appears in the appendix to the appellant's brief (Paper No. 14).

The reference relied upon by the examiner as evidence of obviousness is:

Sotos, British Patent Document 2,252,941 Aug. 26, 1992

Claims 5, 21 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over the British reference.

Reference is made to the appellant's brief (Paper No. 14) and to the examiner's answer (Paper No. 15) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

The British reference discloses a combined ball-point pen and spray device 10. As described in the reference, the device

comprises an elongated tubular body 12 having two

chambers 14, 16 separated by a transverse discoidal wall 18. The first chamber 14 houses a conventional tubular ink supply 20 for a ball point 22 extending through a pointed nozzle 24 of the chamber. The nozzle 24 will usually be covered by a conventional cap with clip (not shown).

The other chamber 16 has at its end remote from the wall 18, in a screwed bush 19, a push button 26 which operates a reciprocating pump generally designated 28. The push button 26 has a pathway 30 from the chamber 16 ending in an outlet 32. In use the chamber 16 will contain perfume and the action of depressing the push button is intended to release a spray of perfume from the chamber 16 [page 2, line 26, through page 3, line 14].

According to the examiner, "[t]he claims appear to be substantially readable on the British Patent. . . . Element #26

is the outermost end" (answer, pages 2 and 3).

The appellant, on the other hand, submits that

[i]n the invention, as set forth in claim 5, "the actuating means has a finger-engageable outermost end, and means for conducting liquid to said outermost end." The British patent discloses a combination ball-point pen and spray device in which the finger-engageable push-button 26 has an internal pathway 30 ending in an outlet on the side of the push-button [brief, page 4].

From this perspective, the appellant argues that

[t]he rejection nowhere makes out a prima facie case of obviousness. Specifically, it does not show where in the prior art there is a suggestion to modify the reference by arranging the fluid passage so that it conducts liquid to the outermost end of

the push-button rather than to the side of the push-button. Indeed, the modification would frustrate the objective of the British patent, which is to spray a liquid. Positioning the outlet at the outermost end of the push-button would prevent spraying from taking place because the user's finger would get in the way [brief, page 6].

Independent claim 5 recites a writing instrument having a sanitary moistener comprising, inter alia, "an elongated, hollow body having first and second ends," a "pump-actuating means . . . projecting axially beyond the second end of the body," the actuating means "being manually depressible, toward the first end of the hollow body" and having "a finger-engageable outermost end," "means for conducting liquid to said outermost end," and "means for allowing moistening liquid to flow through said conducting means to the user's finger while the user's finger is in engagement with the outermost end of the actuating means and depressing said actuating means."

The appellant's position that the British reference does not meet these limitations, particularly those relating to the means for conducting liquid to the outermost end of the actuating means, is well taken. The push button 26 and pathway 30 in the British device correspond, respectively, to

the actuating means and conducting means recited in claim 5. As correctly pointed out by the appellant, the pathway 30 conducts liquid to the side of the push button 26, rather than to its outermost end as required by claim 5. The examiner has not explained, nor is it apparent, why one of ordinary skill in the art would have found it obvious to modify the British pathway 30 so as to have it conduct liquid to the outermost end of the push button 26. The examiner's apparent position that the entire push button 26 constitutes the outermost end of the British actuating means is inconsistent with any reasonable attempt to read the claim limitations in question on the structure disclosed by the reference.

Thus, the British reference does not teach and would not have suggested the subject matter recited in claim 5, or in claims 21 and 23 which depend therefrom. Accordingly, we shall not sustain the standing 35 U.S.C. § 103 rejection of these claims.

The decision of the examiner is reversed.

REVERSED

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IRWIN CHARLES COHEN))
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)	
)	
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